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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,766	03/15/2004	Edward G. Sutt JR.	032228-40100	8637

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NIXON PEABODY, LLP
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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/799,766

Applicant(s)

SUTT, EDWARD G.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-20, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Claims 13-20 and 28-29 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/13/2006.

Applicant is required to update the current status of the related applications as indicated on page 1 of the instant patent application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-12 and 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "to shaft diameter" in claim 10 and "the shaft diameter" in claim 11 lack proper antecedent basis. In claim 21, line 19, the phrase "the plurality" should be replaced with --a plurality--.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-10, 12 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lat et al. (6,086,305; hereinafter Lat'305) in view of Rogers (6,584,915) and White et al. (6,422,447; hereinafter White'447). Lat'305 discloses a steel nail (20) suitable for pallet wooden board securement comprising a substantially round head (22) with a head diameter having a flat top surface and a bottom surface and a single elongate shank (24, 25, 28) integral with the head and extending from the head bottom surface. The shank further including a point (26) opposite the head and a substantially round cross section having a shank diameter between 0.075-0.15 inches and each nail has a length between 1.25-3.5 inches. Lat'305 also discloses the other claimed limitations except for a plurality of surface deformation being formed on the shank, each nail being manufactured from steel wire, attachment structure being constructed and arranged to temporarily attach a plurality of nails into a package and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37.

Rogers shows a plurality of nails (24) formed from wire comprising a substantially round head (28, Figures 2 and 3) having a head diameter, a single elongate shank (26) integral with the head and extending from a head bottom surface, the elongate shank further including a point (30) opposite the head and a plurality of surface deformations (32, 34). Rogers further shows the shank having a shank diameter of about 3.1mm (0.12 inches). White'447 suggests a plurality of nails for roofing with each nail typically has a shank diameter of about 0.12 inches +/- 0.0015 inches and a head diameter of about 0.350-0.438 inches and attachment structure (36) constructed to temporarily attach the plurality of nails into a package. White'447 suggests the ratio of the head diameter (0.350 inches) to shank diameter (0.12) of each nail is between 2.70 and 3.37.

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It would have been obvious to one having ordinary skill in the art in view of Rogers and White'447 to modify the plurality of nails of Lat'305 so each nail is manufactured from steel wire and the shank of each nail comprises a plurality of surface deformations as taught by Rogers to prevent the nails from getting loose from the pallet wooden board and each nail is manufactured with the shank diameter of about 0.12 inches and the head diameter of about 0.35 inches to provide the ratio of the head diameter to shank diameter of each nail is between 2.70 and 3.37 as claimed and it also includes attachment structure constructed and arranged to temporarily attach the plurality of nails into a package as taught by White'447 for better securing the nails into the pallet wooden board and to keep the nails together as the package.

Allowable Subject Matter

6. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb
January 29, 2007



Luan K. Bui
Primary Examiner
Art Unit 3728

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/15/04;6/30/05;9/18/06;9/19/06.